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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/028,867	12/21/2001	Chan U. Ko	AVERP2997USA	4665

7590 09/22/2004
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EXAMINER

CHANG, VICTOR S

ART UNIT PAPER NUMBER

1771

DATE MAILED: 09/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/028,867	Applicant(s) KO ET AL.	
	Examiner Victor S Chang	Art Unit 1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-36 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>8/20/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The Examiner has carefully considered Applicants' remarks filed on 7/15/2004.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Rejections not maintained are withdrawn. In particular, the rejections of sections 5-8 of prior Office action mailed 2/23/2004 are withdrawn for now, and the finality of that action is also withdrawn for now, and to be reinstated in the next Office action upon Applicants' election of restricted groups and species as follows.

Election/Restrictions

4. The Examiner acknowledges that Applicants have elected Invention Group I, claims 1-14, 35 and 36, drawn to a vinyl halide film (Remarks, page 8). The Examiner also acknowledges that Applicants have elected Species 1, homopolymer of vinyl chloride for Species Group I, (Remarks, page 2, bottom paragraph). However, it is noted that Applicants fail to elect one Species from Species Group II. It should be noted that the general test as to when claims are restrictable, respectively, to different species is the fact that one claim recites limitations which under the disclosure are found in a first species but not in a second, while a second claim recites limitations disclosed only for the second species and not the first. See MPEP 806.04(f). Since Applicants' claims direct to various species in Species Group II, for example, claim 6 directs to a nitrile rubber, whereas claim 27 directs to a terpolymer which is distinct and independent from

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nitrile rubber, the restriction requirement by mutually exclusive characteristics is proper.

As such, the Examiner notes that the Applicants' response to restriction requirement is incomplete. The Species Group II is repeated (see Office action dated 4/14/2004, pages 4-5) as follows.

II. Non-halogenated polymeric plasticizer

Species 3: natural rubber (see claims 4, 18).

Species 4: synthetic rubber (see claims 4, 18).

Species 5: polybutadiene rubber (see claims 5, 19).

Species 6: polyisoprene rubber (see claims 5, 19).

Species 7: styrene-butadiene rubber (see claims 5, 19).

Species 8: styrene-isoprene rubber (see claims 5, 19).

Species 9: nitrile rubber (see claims 5, 6, 11, 19, 20).

Species 10: butyl rubber (see claims 5, 19).

Species 11: ethylene-propylene terpolymer (see claims 5, 19).

Species 12: silicone rubber (see claims 5, 19).

Species 13: polyacrylate rubber (see claims 5, 19).

Species 14: epichlorohydrin rubber (see claims 5, 19).

Species 15: fluoroelastomer (see claims 5, 19).

Species 16: polyurethane (see claims 5, 19).

Species 17: ethylene-alpha-olefin rubber (see claim 26).

Species 18: block copolymer of a vinyl aromatic and conjugated diene
(see claim 26).

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Species 19: block copolymer of a vinyl aromatic and functionalized conjugated diene derivative (see claim 26).

Species 20: block copolymer of polyalkylene terephthalate and polyalkylene ether (see claim 26).

Species 21: polyether block polyamide elastomer (see claim 26).

Species 22: polyester block polyamide elastomer (see claim 26).

Species 23: one of the numerous copolymers or terpolymers listed in claim 26, not have been listed above (see claim 26, 27).

Species 24: one of the numerous species listed in claims 30 and 31, not have been listed above (see claims 30 and 31).

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species from each Species Group for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, 1, 3, 7-10, 12-15, 17, 21, 22, 24, 25, 28 and 29 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims

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are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S Chang whose telephone number is 571-272-1474. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Victor S Chang
Examiner
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9/17/2004